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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,463	10/17/2001	Max Stern JR.	STN.0102	5927
7590 12/10/2003 JEFFREY C. MAYNARD 325 CRESWELL ROAD SEVERNA PARK, MD 21146			EXAMINER CAPRON, AARON J	
			ART UNIT 3714	PAPER NUMBER
DATE MAILED: 12/10/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/981,463

Applicant(s)

STERN, MAX

Examiner

Aaron J. Capron

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This is a response to the Amendment received on September 29, 2003, in which claims 1, 3-8 and 12 were amended, claim 17 was added, and claims 10-11 and 13-16 were cancelled.

Claims 1-9, 12 and 17 are pending.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4, 7-9 and 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1, 3, 11 and 16 of copending Application No. 09/981,467. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 4, 7-9 and 12 of the present application "anticipates" application claims 1, 3, 11 and 16 and are not patentably distinct from the patent claims. Thus, it is apparent that the more specific patent claims encompass the application claims. Following in the rationale in *In re Goodman* cited in the previous paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then

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obtain a second patent with a claim for the generic or broader invention without first submitting a terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant traversed the double patenting rejection and argued that the game described in Application No 09/981,467 (hereafter '467) is completely different. However, with respect to Application 09/981,467 (hereafter '463), '463 discloses providing plural sets of contest elements ('467, claim 1, part A), wherein the elements are balls of unique coloring ('467, claim 3); providing a game controller ('467, claim 1, part B); establishing a table of values for winning combinations of contest elements, such table of values including at least one combination consisting of a single a single pre-selected color and a single pre-selected indicia ('467, claim 1, part C, Ci and Cii; both application refer to combinations having the same color and a combination having a single pre-selected indicia is not so limiting as to exclude the use of a sequential series of indicia); distributing means, enabling means, permitting means, distributing means and evaluating means ('467, claim 1, parts D-H). Therefore, the claimed invention fails to distinguish itself from the copending application '467.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody et al. (U.S. Patent No. 5,976,016; hereafter "Moody").

Referring to claims 1-3, Moody discloses a game machine having a typical poker-like game using any game symbol on a game element using any suitable payable (3:55-4:7 and Table 1), but does not disclose using a group of colored balls. However, the feature of balls as game elements, lacking criticality, is considered well within the capabilities of one of ordinary skill to modify the game elements to be used for a particular game theme in order to stand out from other similar poker type games. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a plurality of balls as the game elements of Moody in order to satisfy the particular gaming theme and stand out from other similar poker games. Furthermore, Applicant suggests in the disclosure that other elements, besides a ball, can be used as long as the elements satisfy the distribution of 5 groups with each group having at least 10 elements (Page 8, lines 18-23). Moody discloses a poker type game, but does not specifically disclose that the symbols use a specific order, such as numbers 1-10, of the game elements to indicate a winning combination in a payable. However, it is notoriously well known within the art of poker games to include a standard payable that awards players achieving symbols in a specific order (straight flush consisting of A-2-3-4-5 and a Royal Flush). One would be motivated to provide the ordering of game symbols, such as 0-9 or A-K, and a corresponding payable into Moody in order to attract players who normally play the poker games and prefer higher payouts and since Moody allows alternative game symbols on the game elements with a corresponding payable. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a specific order to

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game symbols and corresponding payable in order to attract players who normally play the poker games and prefer higher payouts.

Referring to claims 4-5, as shown above, Moody discloses a poker type game using game elements that can use the colors red, yellow, blue and green (3:59-63). Moody discloses at least one of the features listed in each of the claims below, but does not teach all of the features such as the color black. However, these “untaught” features are equivalent to the features that are disclosed by Moody since Moody discloses that the game elements can be differentiated by colors and that the color black, lacking criticality, is considered well within the capabilities of one of ordinary skill to modify the game elements to be used for a particular game theme in order to stand out from other similar poker type games. Further, Moody discloses using cards, but does not disclose using a group of colored balls that are numbered from 1-10. However, the feature of balls numbered 1-10 as game elements, lacking criticality, is considered well within the capabilities of one of ordinary skill to modify the game elements to be used for a particular game theme in order to stand out from other similar poker type games. Furthermore, it is notoriously well known with the art of poker games that regular playing cards have the indicia of Ace, 2, 3, 4, 5, 6, 7, 8, 9, 10, Jack, Queen, and King, where the Ace is considered the one card. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a plurality of balls numbered 1-10 as the game elements of Moody in order to satisfy the particular gaming theme and stand out from other similar poker games. Accordingly, Applicant suggests in the disclosure that other elements, besides a ball, can be used as long as the elements satisfy the distribution of 5 groups with each group having at least 10 elements (Page 6, line 21 to Page 7, line 3).

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Referring to claim 6, Moody discloses the number of elements is five (Figure 1) and further that a player has the option to hold and discard game elements and the player receives three four or five redistributed game elements. Alternatively, it is notoriously well known in the art of poker to play with poker hands of three or four game elements in order to differentiate the poker type game from other poker type games and create more interest for the game. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use three or four card poker hands into Moody in order to create more interest in the poker game.

Referring to claim 7, Moody discloses that players can make wagers on the game and win the game based upon a gaming table (abstract and column 4, Table I).

Referring to claims 8-9, Moody discloses that the game is controlled and played on an electronic video game machine and a computer (1:19-30).

Claims 12 and 17 correspond in scope to a game set forth for use of the method listed in the claims above and are encompassed by use as set forth in the rejection above. Referring to claim 12, as shown above, Moody discloses a poker type game that includes 5 sets of game elements wherein each set includes at least 40 balls ( $250 \text{ balls} / 5 \text{ sets of colors} = 50 \text{ balls per set}$ ; 3:45-63).

### ***Response to Arguments***

Applicant's arguments filed September 29, 2003 have been fully considered but they are not persuasive.

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Applicant argues that Moody does not disclose that the playing elements are balls of a unique colors and a Table of Values that rewards a player who obtains at least one specific combination of preselected color and indicia. However, Moody provides a paytable (Column 4, Table 1) that provides the combination of preselected colors and indicia. Further, the feature of balls as game elements, lacking criticality, is considered well within the capabilities of one of ordinary skill to modify the game elements to be used for a particular game theme in order to stand out from other similar poker type games. As stated by the Applicant in the disclosure, other elements, besides a ball, can be used as long as the elements satisfy the distribution of 5 groups with each group having at least 10 elements (Page 8, lines 18-23). The game ball, if replaced by a playing card or vice versa, would not differentiate the method for conducting a game in a manner that would exclude the obviousness rejection of Moody. Therefore, the claimed invention fails to preclude the obvious type rejection of Moody.

Applicant argues that color can be a critical element when considering a billiards or pool game. However, with respect to Moody and a poker game, the specific color black fails to lack criticality. This “untaught” feature is equivalent to the features that are disclosed by Moody since Moody discloses that the game elements can be differentiated by colors and that the color black, lacking criticality, is considered well within the capabilities of one of ordinary skill to modify the game elements to be used for a particular game theme in order to stand out from other similar poker type games. The color black, if replaced by another color or vice versa would not differentiate the method of conducting a game in manner that would exclude the obviousness rejection of Moody. Therefore, the claimed invention fails to preclude the obvious type rejection of Moody.



***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Weingdart (U.S. Patent No. 5,042,818) discloses offering higher payouts if a player achieves a particular card hand in order or in sequence (8:3-5).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-Th 8-6.

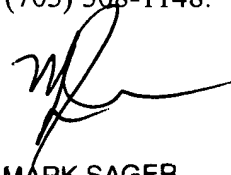
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

A handwritten signature in black ink, appearing to read 'MS', with a long horizontal flourish extending to the right.

MARK SAGER  
PRIMARY EXAMINER

ajc